

REMARKS

I. Status of Claims

Claims 1-100 are pending in this application. Claims 7-16, 18, 20, 21, 34-42, 55-64, 66-69, and 82-90 have been withdrawn by the Examiner as related to non-elected subject matter. Office Action dated February 9, 2004 ("February 9 Office Action"), page 2. Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, and 91-100 are subject to examination. No amendment is made in this Reply.

II. Double Patenting Rejection

The Examiner rejects claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, and 91-100 under non-statutory obviousness-type double patenting as being unpatentable over claims 44-146 of U.S. Patent No. 6,486,105. Outstanding Office Action, page 2. As indicated in the Reply dated May 10, 2004, Applicants respectfully traverse this rejection, but request that this rejection be held in abeyance until allowable subject matter is indicated. At that time, Applicants will consider whether or not to file a Terminal Disclaimer.

III. Rejection under 35 U.S.C. § 103

The Examiner rejects claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, and 91-100 under 35 U.S.C. § 103(a) as being unpatentable over Karlen et al. (U.S. Patent No. 6,004,545) ("*Karlen*") in view of Bertho et al. (U.S. Patent 5,688,930) ("*Bertho '930*") or Bertho et al. (U.S. Patent No. 6,087,403) ("*Bertho '403*"). Outstanding Office Action, page 3. Applicants respectfully disagree for at least the following reasons.

First, the Examiner has failed to point to any evidence of teaching or suggestion for a “method of protecting at least one keratinous fiber from extrinsic damage or repairing at least one keratinous fiber following extrinsic damage” as recited in the rejected claims, such as claims 1 and 49, of the present invention. Instead, the Examiner contends that “when people use the hair care products as suggested by the prior art, the recited function would be inherently realized.” February 9 Office Action, page 5. Applicants respectfully submit that the Examiner’s position is improper.

The Examiner’s inherency argument cannot prevail for an obviousness rejection under § 103(a), especially in view of the fact that the rejected claims herein are method claims, because “[o]bviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established.” M.P.E.P. § 2141.02 (page 2100-126, Rev. 2, May 2004 edition) (citing *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993)); see *In re Shetty*, 566 F.2d 81, 86, 195 U.S.P.Q. 753, 756-57 (C.C.P.A. 1977) .

In *Shetty*, the court reversed the USPTO’s § 103(a) rejection of method claims directed to using a composition of certain adamantane compounds to curb appetite in animals. *Shetty*, 195 U.S.P.Q. at 756-57. Specifically, the USPTO’s § 103(a) rejection of the method claims is based on the arguments that the prior art references teach structurally similar compounds for use as antiviral agents, with recommended dosages that correspond to those claimed, therefore, administering the prior art compound in a claimed amount would inherently achieve appetite curbing and thus render the claimed method obvious. *Id.* at 756. But the court rejected such arguments and opined that “[p]rior to appellant’s disclosure, none of the adamantane compounds in any of the

references [cited therein] suggested a use, much less a dosage, for curbing appetite” and “the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.” *Id.* at 757.

Similar to *Shetty*, here, none of the references cited by the Examiner teaches or suggests a use, much less an amount, of the composition as claimed for protecting keratinous fibers from extrinsic damage and/or repairing keratinous fibers following extrinsic damage. In other words, the use of the composition as claimed for protecting keratinous fibers from extrinsic damage and/or repairing keratinous fibers following extrinsic damage was not known at the time when this invention was made. Therefore, such a method of use as claimed in the present invention cannot be obvious.

Additionally, the Examiner has failed to point to any evidence of suggestion or motivation in the cited references to use the “at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁ to C₂₂ carbon chain” as recited in the rejected claims, such as claims 1 and 49, of the present invention. The Examiner relies on *Karlen* for its teaching of a hair cleansing composition with fixing properties containing amphoteric film-forming polymers such as AMPHOMER LV-71 and nonionic surfactants such as alkylpolyglucosides. *Id.*; February 9 Office Action, pages 3-4. However, independent claim 1 merely recites, in part, “at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁ to C₂₂ carbon chain” without reciting any film-forming polymer. Further, because alkylpolyglucosides are derivatives of glucose that has 6 carbon atoms, the alkylpolyglucosides disclosed in

Karlen do not fall into the scope of the at least one compound as recited in Claim 1 of the present invention.

The Examiner then relies on *Bertho '930* for its teaching of "mixtures of alkyl glycosides from wheat by products" including "glucose, xylose, and arabinose." Outstanding Office Action, page 3; February 9 Office Action, page 4. However, the mixture disclosed in *Bertho '930* includes derivatives of both C₅ monosaccharides (*i.e.*, xylose and arabinose) and C₆ monosaccharides (*i.e.*, glucose) and the Examiner has not pointed to any evidence of teaching or suggestion to pick and choose the derivatives of C₅ monosaccharides from the mixture.

Similarly, the Examiner relies on *Bertho '403* for its teaching of "emulsifying compositions based on fatty alcohols and polyglycoside mixtures." Outstanding Office Action, page 3; February 9 Office Action, page 4. And the polyglycoside mixtures disclosed in *Bertho '403* include derivatives of both hexose (a C₆ monosaccharide) and pentose (a C₅ monosaccharide). Col. 3, lines 1-32. Again, the Examiner has not pointed to any evidence of teaching or suggestion to pick and choose the derivatives of C₅ monosaccharides from this polyglycoside mixture.

Reading all three references together, it may have been obvious to use derivatives of C₆ monosaccharides, but there is no teaching or suggestion to use a C₅ monosaccharide. Indeed, the teaching of a C₆ monosaccharide teaches away from the presently claimed invention. Therefore, this rejection is improper.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

IV. Conclusion

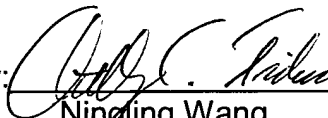
In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application, and the timely allowance of the pending claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned Applicants' representative at (202) 408-4218.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Date: November 22, 2004